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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,857	05/03/2001	Hideki Itaya	HCD11785	9838
7590 05/05/2006				
Douglas A. Chaikin, Esq. PENINSULA IP GROUP 26150 Bucks Run Corral de Tierra, CA 93908			EXAMINER LUDLOW, JAN M	
			ART UNIT 1743	PAPER NUMBER
DATE MAILED: 05/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,857

Applicant(s)

ITAYA ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. The amendment after final rejection filed on June 28, 2005 has been entered.
2. The indicated allowability of claims is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.
3. Claim 15 is objected to because of the following informalities: In line 1, "A instrument having overlapping carousel instrument" is informal. Appropriate correction is required.
4. Claims 1, 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, it is not clear what is encompassed by the term "transfer mechanism for transferring"—does this refer to the valve at the tip of the pipette, the aspiration element or both or either? Note that claim 18 recites the aspiration structure as part of the transfer mechanism. The examiner notes that it is not clear that opening the valve at the tip is sufficient to provide transfer without the aspiration element.

Throughout the claims, it is unclear what is encompassed by the term "carousel" because in claims 13 and 15, the term "rotatable" is used in conjunction with carousel, whereas a carousel is by definition rotatable (see paragraph 9 of the Office Action mailed July 13, 2004)—does applicant intend to encompass stationary tables by the broad recitation of carousel? For purposes of examination, "carousel" has been interpreted as having its common meaning, i.e., "a rotatable circular device."

Throughout the claims, "diagnostic carousel" is unclear because it is not clear what structure differentiates a "diagnostic carousel" from any other carousel.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3-5, 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ammann (US 20020098117A1).

Ammann teaches sample carousel 250 holding tubes 320. A second carousel (instant diagnostic carousel) 350 holding pipette tips is above and offset (having a different central axis) from carousel 250 (Figures 5-6, [0107-0108 and elsewhere]). In that the instant pipettes are tubes connectable to an aspiration device, the pipette tips of Ammann are seen to read on the instant pipettes because they too are tubes connectable to an aspiration device. A pipette (tip) is secured to a transfer mechanism 450 coupled to a syringe pump for transferring sample directly from tube 320 into the pipette (tip) when the tip is lowered into the tube, and the transfer mechanism is moveable in XYZ directions by stepper motors, constituting the instant rotary elevators (i.e., the device elevates, and at least some part of a stepper motor rotates) [0110-0112, 0116 and elsewhere].

10. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ammann as applied to claims above.

11. Ammann fails to teach the number of tubes.

12. It would have been obvious to one of ordinary skill in the art to provide any number of sample tubes in order to process a desired plurality of samples in a table of

desired compact size. It would have been further obvious to provide as many pipette (tips) as sample tubes in order to use a different tip for each sample to prevent cross-contamination [0116].

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ammann as applied to claims above and further in view of Cloonan (US005915583A).

14. Ammann fails to teach a tube with an open proximal end and a cup in the proximal end.

15. Cloonan teaches tubes 12A, 12B with cup 10 in the open end.

16. It would have been obvious to provide a tube with a cup in the open end in the invention of Ammann in order to provide a small sample in a larger tube for automated analysis as taught by Cloonan (Background).

17. Claims 15-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

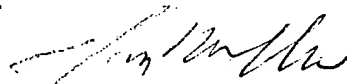
18. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter: Ammann fails to teach or suggest unique identifying indicia on each of the sample tubes and pipettes (tips) and means for reading, matching and aligning the appropriate tube and pipette. Ammann fails to teach that the transfer mechanism operates at the zone of intersection as defined in that transfer takes place in a portion of the sample carousel that does not intersect the diagnostic carousel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml
May 2, 2006